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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,769	06/15/2001	Georg Egloff	T2861-907262	5919

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EXAMINER

PICKARD, ALISON K

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/880,769

Applicant(s)

EGLOFF, GEORG

Examiner

Alison K. Pickard

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 30 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 8, 13, and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Udagawa (4,869,516).

Udagawa discloses a gasket (and method of making) comprising at least one metal layer 25 having a metal ring 23 welded thereto over a welding bead 26. The bead maintains the layer and ring in a spaced-apart relationship (e.g. see Fig. 2). The layer and ring are spaced from each other a distance that is constant around a through-hole, or the distance varies closer to and due to the projection of the weld bead or bead 25a. The gasket comprises two metal layers (Fig. 3). The metal layers have sealing beads. The layer and ring comprise steel.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (5,690,342) in view of Opprecht (4,850,214).

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Tanaka discloses a gasket and method of manufacturing a gasket comprising at least one metal layer 1 (or 3) having at least one through-hole and at least one metal ring 2 welded thereto (col. 3, lines 65-67). Tanaka discloses the ring and layer can both be stainless steel. Tanaka discloses sealing beads 13 arranged opposite each other and beads 10 and 13 offset from each other. A further metal ring is arranged around the bead (see Figs. 5A and 5B). At least one of the metal layers 1 and 3 has a cranking 10 to align the metal ring 2. Tanaka discloses that the layer and ring are welded together. However, Tanaka does not disclose that layer and ring are welded together over a welding bead (i.e. via projection welding). Opprecht teaches that projection welds are used to obtain a high quality connection between metal components. Opprecht teaches that projection welding creates a better weld that is easier and more efficient to manufacture. Opprecht teaches that projection welding includes a projection (u-shaped) along which the items are welded together. Opprecht teaches using deformation limiters/abutments (see Fig. 8) during the welding to maintain the strength of the projection. As seen in Figures 3 or 4, the two substrates would be maintained in a spaced-apart relationship. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the weld used in Tanaka with the projection weld taught by Opprecht to create a higher quality connection that is easier and more efficient to manufacture.

### ***Response to Arguments***

5. Applicant's arguments filed 6-30-03 have been fully considered but they are not persuasive.

The cited prior art shows various gaskets having two metal layers (i.e. a metal layer and metal ring) welded together. The cited prior art shows that it is known to use laser welding

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including spot welding or projection welding (see Kakuta or Udagawa '516 for examples) to join the layers together.

Applicant argues that there is no suggestion to combine the references. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Applicant also argues that Opprecht is nonanalogous art. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, Tanaka discloses a gasket comprising a metal layer and metal ring. As acknowledged by Applicant, Tanaka discloses the ring and metal layer are welded together. However, Tanaka does not give any details as to how the weld is formed (i.e. that a projection weld is used). Opprecht teaches welding. More specifically, Opprecht teaches that projection welding is more commonly used and produces a higher quality connection than spot welding. It is this teaching and motivation that is being applied to Tanaka. It would have been obvious to one of ordinary skill in the art looking to connect these pieces together via a weld to consider welding art teachings, such as Opprecht, to produce the highest quality connection. The pieces would also be maintained in a spaced-apart relationship. Further, it would have been obvious to

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one of ordinary skill in the art to select the projection weld because it is known that a projection weld allows the pieces to be maintained in a spaced-apart relationship (i.e. parallel) so that the gasket can function properly and effectively as evidenced by Udagawa '516.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 703-305-0882.

The examiner can normally be reached on M-F (9-6:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1113.



Alison K. Pickard  
Examiner  
Art Unit 3676

AP